



28 FEB 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Morgan, Lewis & Bockius, LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

In re Application of	:	
HUDD	:	
Application No.: 10/520,977	:	
PCT No.: PCT/US02/15774	:	SUPPLEMENTAL
Int. Filing Date: 16 May 2002	:	
Priority Date: 30 May 2001	:	DECISION
Attorney Docket No.: 056222-5085-US	:	
For: INKJET MAINTENANCE KIT	:	

This decision supplements the decision in this application mailed 25 February 2005.

BACKGROUND

On 11 January 2005, applicant filed a petition to revive the present application.

On 25 February 2005, applicant was mailed a decision granting applicant's petition.

On 23 May 2005, applicant was mailed a "Notification of Acceptance" (Form PCT/DO/EO/903).

DISCUSSION

Upon further review of the facts of the abandonment it has been determined that the Office erred in initially granting applicant's petition.

As detailed in the decision mailed 25 February 2005, under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

Applicant previously satisfied items (1), (2), and (4) above.

With regard to item (3), the petition states that the present application was unintentionally abandoned due to a docketing error.

MPEP 711.03(c), Section II. E. states in relevant part,

The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party has reassigned the application to the applicant prior to the due date for the reply. *Id.*

In the present case, the inventors Alan Hudd and Philip Bentley assigned the entire right, title, and interest in the present application to 3M Innovative Properties Company ("3M"). Furthermore, the "Sponsored Development Agreement"¹ between 3M and Xennia Technology Limited ("Xennia") states that Xennia assigns all right, title, and interest in the invention to 3M. Moreover, the "Sponsored Development Agreement" states that 3M shall have the exclusive right to file, prosecute, issue, maintain, license, enforce, and defend the present patent application and patents derived therefrom. An assignment of the entire right, title, and interest passes both legal and equitable title. *Wende v. Horine*, 191 F. 620, 621 (C.C.N.D. Ill. 1911). Therefore, having been assigned the entire right, title, and interest in the present application by virtue of the recorded assignment agreement and/or the "Sponsored Development Agreement", 3M is the party which had legal and equitable title to the invention from the assignment date until at least 30 November 2003. Thus, 3M had sole authority to reply in order to avoid abandonment.

The petition states that 3M had an obligation to notify Xennia of any intent to abandon the application and that 3M agreed to take no action to abandon the application for a specified period. However, even if 3M breached any duties set forth in its contract with Xennia, 3M retained legal and equitable title to the present invention. See *Wende*. A reversionary interest exists only if there is a conveyance of less than the entire interest. *Kim*, 718 F. Supp. at 1283. Moreover, even if an assignment agreement provides for the possibility of reassignment back to the assignor, the assignor does not retain any reversionary interest in the invention. See *Kim* at 1283. Thus, even though the "Sponsored Development Agreement" provided for the possibility of reassignment back to Xennia, because the entire right, title, and interest in the present invention had been assigned to 3M, neither the inventors nor Xennia retained any reversionary interest. Applicant has not made any showing that 3M surrendered or transferred title to the present invention back to the inventors, Xennia, or any other party before the present application became abandoned.

MPEP 711.03(c), Section II. C. 1. states in relevant part,

¹ It is noted that transfer or assignment of the present invention from the inventors to Xennia has not been established.

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

In the present case, the evidence shows that the party having the sole right to reply in order to avoid abandonment (i.e. 3M) deliberately permitted the present application to become abandoned. The 11 January 2005 petition states, "On September 22, 2003, the business unit responsible for the PCT patent application decided to discontinue prosecution of the patent application." Furthermore, "On October 28, 2003, the docketing clerk mailed a letter to 3M's prosecuting attorney of the PCT patent application at Vossius & Partner, located in Germany, communicating that 3M decided to discontinue prosecution of the PCT patent application referenced above." Thus, 3M's deliberate decision to abandon the present application has been clearly established. An intentional abandonment of an application precludes a finding of unintentional delay pursuant to 37 CFR 1.137(b). See *Maldague*.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice. This application is abandoned as to the National stage in the United States of America.

The decision mailed 25 February 2005 is hereby **VACATED**.

The "Notification of Acceptance" (Form PCT/DO/EO/903) mailed 23 May 2005 is hereby **VACATED**.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136 pursuant to 37 CFR 1.137(e)(1). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "Derek A. Putonen". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459